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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,144	02/14/2002	Doreen S. Rao	BSC-201 (1002/276)	6889
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
MCEVOY, THOMAS M				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
01/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/075,144

**Applicant(s)**

RAO ET AL.

**Examiner**

THOMAS MCEVOY

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14, 15, 17-20, 22, 23, 28-34, 36-42, 45-53, 60-64 and 66-76 is/are pending in the application.
- 4a) Of the above claim(s) 4, 5, 7, 10-12, 15, 18-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8, 9, 14, 17, 22, 28-34, 36-42, 45-53, 60-64 and 66-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Currently claims 1-12, 14, 15, 17-20, 22, 23, 28-34, 36-42, 45-53, 60-64 and 66-76 are pending. Claims 4, 5, 7, 10-12, 15, 18-20 and 23 have been withdrawn. Claims 13, 16, 21, 24-27, 35, 43, 44, 54-59 and 65 have been cancelled. Claims 1-3, 6, 8, 9, 14, 17, 22, 28-34, 36-42, 45-53, 60-64 and 66-76 are considered below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, 8, 9, 14, 36-42, 45, 47, 48, 61, 62 and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Jellinek (US 2,274,269).

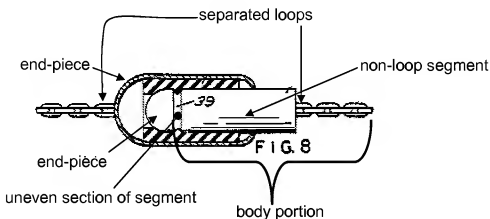
Regarding claims 1-3, 6, 8, 9, 14, 36-38, 40-42, 48, 61 and 68, Jellinek discloses a device capable of treating a body canal, comprising: a proximal end-piece 14 positioned at a proximal-most end of said device; a distal end-piece 10 positioned at a distal end of said device, the end pieces having substantially the same non-looped shape (Figure 1); and an elongated body portion disposed between said proximal end-piece and said distal end-piece, said body portion comprising a plurality of interconnected closed circular loops 5 (Figure 3) configured to fit within said body canal and movable within each other along an X, Y, or Z axis, each of said loops comprising a member defining at least one opening, the member of each loop passing through at least one opening of another loop to form said plurality of interconnected loops, and

wherein the elongated body portion further comprises a substantially cylindrical non-loop segment 2/13 comprising a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop of said interconnected loops (Figure 2), a diameter the end-pieces being larger than a diameter of a remainder of the device (Figure 3). Regarding claim 39, an axial length of the body portion is adjustable either by re-orienting the chain or by attaching the pin 13 at different points to the fastener 15 (Figure 4). Regarding claims 45, 47 and 62, the device is a solid object and any solid under enough stress is compressible.

4. Claim 61 is rejected under 35 U.S.C. 102(b) as being anticipated by Dorsey (US 4,543,695).

Regarding claim 61, Dorsey discloses a device for treating a body canal, comprising: a proximal end-piece, 10 or 25, positioned at a proximal-most end of said device; a distal end-piece, 10 or 25, positioned at a distal end of said device, the end-pieces having substantially the same non-looped, substantially spherical shape (half-sphere blunt ends); and an elongated body portion disposed between said proximal end-piece and said distal end-piece, said body portion comprising a plurality of discrete, circular, closed, interconnected loops configured to fit within said body canal, each of said loops comprising a member defining at least one opening, the member of each loop passing through at least one opening of another loop to form said plurality of interconnected loops, and wherein the elongated body portion further comprises a substantially cylindrical non-loop segment made of compressible material (any solid under enough stress is compressible) connected to at least one of said interconnected

loops, a diameter of at least one of the end pieces being larger than a diameter of a remainder of the device. The body portion comprises a chain which has an axial length that is movable in the X, Y or Z planes. The non-loop segment separates multiple loops when the device is connected. See below (Figure 8):



### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22, 28-34, 46, 49-53, 63, 64, 69-72, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jellinek (US 2,274,269) in view of Marlo et al. (US 5,253,366).

Regarding claims 22, 28, 29, 32-34, 46, 49-53, 63, 64, 69-72, 74, and 75, Jellinek discloses the device as described above where the end-pieces are capable of holding

the device in a urinary bladder or renal pelvis. Jellinek fails to disclose that the end-pieces are spherical. Jellinek discloses that the device is intended to convert clips into pendants. Marlo et al. disclose that a tie clip where ornamental spheres are attached to the clothing by separate clip mechanisms. It would have been obvious to one of ordinary skill in the art to have used the pendant mechanism of Jellinek to attach the spheres of Marlo et al. because this would provide a simpler means of attachment and allow the clip of Marlo et al. to be worn as a pendant which is a stated goal of Jellinek. Regarding claims 30 and 31, Jellinek does not specifically disclose how the loops are indirectly attached to the end-pieces. However, it is old and well known in the art that articles of jewelry are connected by welding or soldering.

7. Claims 60, 66, 73 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jellinek (US 2,274,269) in view of Marlo et al. (US 5,253,366) and further in view of Otto (US 2,248,100).

Regarding claims 60, 66, 73 and 76, Jellinek in view of Marlo et al. disclose the device as described above where both the Jellinek and Marlo et al. devices are intended to be combined with necklaces. Jellinek in view of Marlo et al. fail to disclose that the device is biodegradable. Otto teaches that iron (a bioerodible/biodegradable material) should be added to necklaces and other articles of jewelry so that it can be consumed by bioerosive and other processes thereby protecting the precious metals of the jewelry. It would have been obvious to one of ordinary skill in the art to have constructed the necklace out of precious metals incorporating iron as an obvious matter of design choice because Jellinek gives no specific disclosure for the material of the

necklace (leaving this as a design option) and Otto suggests an advantageous composition.

8. Claims 60 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jellinek (US 2,274,269) in view of Otto (US 2,248,100).

Regarding claims 60 and 67, Jellinek discloses the device as described above which is intended to be combined a necklace. Jellinek fails to disclose that the device is biodegradable. Otto teaches that iron (a bioerodible/biodegradable material) should be added to necklaces and other articles of jewelry so that it can be consumed by bioerosive and other processes thereby protecting the precious metals of the jewelry. It would have been obvious to one of ordinary skill in the art to have constructed the necklace out of precious metals incorporating iron as an obvious matter of design choice because Jellinek gives no specific disclosure for the material of the necklace (leaving this as a design option) and Otto suggests an advantageous composition.

9. Claims 60 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorsey (US 4,543,695) in view of Otto (US 2,248,100).

Regarding claims 60 and 66, Dorsey discloses the device as described above but fails to disclose that the loops are made of biocompatible material. Otto teaches that iron (a bioerodible/biodegradable material) should be added to necklaces and other articles of jewelry so that it can be consumed by bioerosive and other processes thereby protecting the precious metals of the jewelry. It would have been obvious to one of ordinary skill in the art to have constructed the necklace out of precious metals

incorporating iron as an obvious matter of design choice because Otto suggests an advantageous composition which can preserve the life of the necklace.

***Response to Arguments***

10. Applicant's arguments filed September 18<sup>th</sup> 2008 have been fully considered but they are not persuasive. Applicant argues that Dorsey does not disclose a compressible material. Examiner respectfully disagrees. Dorsey discloses that stud 24 can be a hollow tubular structure (col. 2, lines 55-58). Examiner maintains that any solid, especially the hollow tubular stud 24, if under enough stress will be capable of compressing. Applicant argues that the rejection of Dorsey in view of Gardner is improper because they are not analogous art to medical devices. The scope of Applicant's claims are directed to treatment of any body canal. This does not limit the scope of the claims to medical devices. Any mechanical device can be used to treat a body canal, either interiorly or exteriorly. The remainder of Applicant's arguments are moot in view of the new grounds of rejection.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas McEvoy whose telephone number is (571) 270-5034. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TM

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731